

REMARKS

This Amendment is submitted in response to the Office Action dated May 20, 2009, having a shortened statutory period set to expire August 20, 2009. Applicant has canceled claims 70-77 without prejudice or disclaimer to the subject matter recited therein. Applicant has added new claims 170-177. Claims 1-69 and 78-177 are pending. Reconsideration of the present case is earnestly requested in light of the following remarks.

I. Double Patenting Rejections

Claims 1-169 were rejected on the ground of nonstatutory obvious-type double patenting as being unpatentable over various claims of U.S. Patent Nos. 5,835,061; 5,969,678; 6,326,918; and 6,697,018. This rejection is respectfully traversed.

Applicant respectfully submits that the Examiner has not made clear any reason why a person of ordinary skill in the art would conclude that the claims at issue would have been an obvious variation of the claims in the cited patent(s). "Any obviousness-type double patenting rejection should make clear: ☐ The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue >is anticipated by, or< would have been an obvious variation of >,< the invention defined in a claim in the patent." *MPEP* § 804(II)(B)(1). Applicant also notes "[A]nalysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)." *MPEP* § 804(II)(B)(1). Applicant further notes "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *MPEP* § 2141(III). Thus, Applicant respectfully submits that claims 1-69 and 78-177 are not subject to the non-statutory obvious-type double patenting rejections cited by the Examiner and are allowable for at least the reason(s) provided. However, Applicant herewith submits a terminal disclaimer in compliance with 37 C.F.R. §1.321(c) to overcome any actual or provisional rejection based on non-statutory obviousness-type double patenting of the pending claims. U.S. Patent Nos. 5,835,061; 5,969,678; 6,326,918; and 6,697,018 are commonly owned by the Assignee of the present application. Therefore, it is believed the attached terminal disclaimers

will overcome any actual or provisional obviousness-type double patenting rejection of the pending claims.

II. Claim Rejections Under 35 U.S.C. § 101

Claims 70-77 and 92-110 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant has canceled claims 70-77 without prejudice or disclaimer to the subject matter recited therein, and Applicant has amended claims 92-110 and believes these claims are directed to statutory subject matter and are allowable for at least the reason(s) provided.

III. Claim Rejections Under 35 U.S.C. § 112

A. § 112, First Paragraph

Claims 17, 37, 44, 49, 73, 98, 107, 108, 124, 137, 149, and 161 were rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Examiner stated, "For claim 44, the examiner cannot find any disclosure in the specification regarding the content indicating a route from the geographic location of the computing device to the destination. Claims 17, 37, 49, 73, 98, 107, 108, 124, 137, 149, and 161." Applicant respectfully submits that content indicating and disclosing a route can be found in Applicant's Specification at least on page 7, line 38 through page 8, line 9:

Another feature according to the invention allows the user to access a service provider over a network connected through the access point. For example, upon establishing its location, a mobile unit can direct an inquiry through the AP over the network connected to the user's bank to locate the nearest ATM. Since the user's location is established with relative precision by the location of the AP, the service provider can respond with a message such as "Straight ahead to exit 3, turn right and proceed two blocks." The message is routed to the user through the same AP.

Thus, Applicant respectfully submits that claims 17, 37, 44, 49, 73, 98, 107, 108, 124, 137, 149, and 161 are allowable for at least the reason(s) provided.

B. § 112, Second Paragraph

Claims 63-69 were rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claims 63-68. Applicant respectfully submits that claims 63-69 are allowable for at least the reason(s) provided.

IV. Claim Rejections Under 35 U.S.C. § 103

A. *Singer et al.* is not sufficient for *prima facie* obviousness

Claims 43, 46, 50, 54, 55, 59, 60-63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Singer et al.* (U.S. Patent No. 5,485,163, hereinafter "*Singer*"). This rejection is respectfully traversed.

1. Change of the principle of operation of the prior art being modified

The Examiner stated, "For claim 63, *Singer* discloses. . . *Singer* does not disclose that the two devices are one. [] However, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of *Singer* to incorporate the two devices in order to provide location services to the PLU wearer with a single device and to make devices less cumbersome." (emphasis added).

Applicant respectfully submits that modifying, as the Examiner suggests, the portable locator unit (PLU) 4 by combining it with the separate and distinct mobile unit 6 "would change the principle of operation" described by *Singer*. See MPEP § 2143.01(VI). Applicant points out that *Singer* describes the principle of operation of providing a remote location of PLU 4 to the separate and distinct mobile unit 6 so that a user of mobile unit 6 can be directed to and find the remote location of PLU 4. For example, *Singer* provides a brief summary that indicates the principle of operation of providing a remote location of PLU 4 to the separate and distinct mobile unit 6: "After having determined the location of the PLU [4] from the received information, the network location processor forwards this information to a designated source, such as the requesting subscriber [mobile unit 6] or other authorized user." (*Singer*: col. 2, lines 6-9).

Singer provides additional details in col. 3, line 61 – col. 4, line 47. Applicant submits that combining PLU 4 and mobile unit 6, as the Examiner suggests, would not allow providing a remote location of PLU 4 to mobile unit 6 so that a user of mobile unit 6 can be directed to and find the remote location of PLU 4, since the PLU 4 and mobile unit 6 are in the same location. The combination of PLU 4 and mobile unit 6 would change the principle of operation described by *Singer* by rendering the function irrelevant to the mobile device. Consequently, Applicant submits that the proposed modification of *Singer* is improper for purposes of making a rejection under 35 U.S.C. §103 because it changes the principle of operation of *Singer*. (See, e.g., *MPEP* § 2143.01(VI), "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) []." Thus, Applicant respectfully submits that a *prima facie* case of obvious has not been established to reject claims 1-69 and 78-177. Accordingly, claims 1-69 and 78-177 are nonobvious and allowable for at least the reason(s) provided.

2. Proposed modification of *Singer* teaches away from such modification

As discussed above, *Singer* describes providing a remote location of PLU 4 to the separate and distinct mobile unit 6 so that a user of mobile unit 6 can be directed to and find the remote location of PLU 4. Thus, combining PLU 4 with the separate and distinct mobile unit 6, would no longer permit mobile unit 6 to be directed to a remote location of PLU 4. Accordingly, the Examiner's modification of combining mobile unit 6 and PLU 4 "would be rendered inoperable for its [their] intended purpose[s]", and "[i]n effect, [] teaches away from the board's [Examiner's] proposed modification." *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Applicant respectfully points out that "[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997) []." *MPEP* § 2144.05(III). Thus, Applicant respectfully submits that a *prima facie* case of obvious has not been established to reject claims 1-69 and 78-177. Accordingly, claims 1-69 and 78-177 are nonobvious and allowable for at least the reason(s) provided.

3. No support for a legal conclusion of obviousness

The Examiner stated, "For claim 63, Singer discloses. . .Singer does not disclose that the two devices are one. [] However, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Singer to incorporate the two devices in order to provide location services to the PLU wearer with a single device and to make devices less cumbersome." (emphasis added).

Applicant respectfully disagrees and submits that modifying the portable locator unit (PLU) 4 with the mobile unit 6 described by *Singer* would make PLU 4 more cumbersome. *Singer* describes that PLU 4 "has the form of a tag, an ornamental bracelet, or the like." (*Singer*: col. 2, line 33). *Singer* further describes that PLU 4 "with appropriate miniaturization it could be incorporated in almost any object, such as a belt, watch, earring, etc." (*Singer*: col. 2, lines 36-37) (emphasis added). *Singer* also describes mobile unit 6 as a pager with an alphanumeric display or a cellular telephone. "Where mobile unit 6 is an alphanumeric pager, the information can be displayed upon a pager display. On the other hand, where mobile unit 6 is a cellular telephone, the information can be forwarded in a voice format." (*Singer*: col. 4, lines 39-42). Thus, combining mobile unit 6 and PLU 4, as the Examiner suggests, would not permit PLU 4 to be miniaturized to be apparel such as an ornamental bracelet, a watch, an earring, etc.

Therefore, the Examiner's modification voids and/or nullifies the Examiner's stated objective reason to combine the teachings of the reference. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)." *MPEP* § 2143.01(IV). Thus, Applicant respectfully submits that a *prima facie* case of obvious has not been established to reject claims 1-69 and 78-177. Accordingly, claims 1-69 and 78-177 are nonobvious and allowable for at least the reason(s) provided.

4. No suggestion or motivation to make the proposed modification

Singer teaches away from combining PLU 4 and mobile unit 6, since this combination would make PLU 4 more cumbersome. *Singer* describes that PLU 4 "has the form of a tag, an ornamental bracelet, or the like." (*Singer*: col. 2, line 33). *Singer* further describes that PLU 4 "with appropriate miniaturization it could be incorporated in almost any object, such as a belt,

watch, earring, etc." (*Singer*: col. 2, lines 36-37) (emphasis added). *Singer* also describes mobile unit 6 as a pager with an alphanumeric display or a cellular telephone. "Where mobile unit 6 is an alphanumeric pager, the information can be displayed upon a pager display. On the other hand, where mobile unit 6 is a cellular telephone, the information can be forwarded in a voice format." (*Singer*: col. 4, lines 39-42). Thus, combining mobile unit 6 and PLU 4, as the Examiner suggests, would not permit PLU 4 to be miniaturized to be apparel such as an ornamental bracelet, a watch, an earring, etc. Applicant respectfully submits that combining mobile unit 6 and PLU 4, as the Examiner suggests, would render the prior art invention being modified unsatisfactory for its intended purpose, in this case, to remain miniaturized apparel and therefore be less noticeable and more likely to remain on the person of the wearer. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) []." MPEP § 2143.01(V).

B. Combination of *Singer* and *Muffat et al.*

Claims 44, 45, 47-49, and 51-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Singer* in view of *Muffat et al.* ("European Cooperation on Dual Mode Route Guidance-Perspectives for Advanced Research Partners", hereinafter "*Muffat*"). This rejection is respectfully traversed.

Applicant respectfully submits that *Singer* and *Muffat* cannot be combined, since *Singer* teaches away from a combination with *Muffat*. Applicant points out that *Singer* teaches away from on-board devices of automobiles (e.g., cars, trucks, etc.). See *Singer* col. 1, lines 29-46 which includes *Singer's* reference to U.S. Pat. No. 5,218,367 that describes on-board devices and their services of automobiles. *Singer* states such devices and their services associated with on-board devices of automobiles would "add undesirable bulk", such as a "car battery" or even an entire car. (*Singer*: col. 1, lines 44-45 and 34).

Accordingly, Applicant respectfully submits that *Singer* teaches away from a combination with *Muffat*. "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) []." MPEP § 2145 (X)(D)(2). Thus, Applicant respectfully submits that a *prima facie* case of

obvious has not been established to reject claims 1-69 and 78-177. Accordingly, claims 1-69 and 78-177 are nonobvious and allowable for at least the reason(s) provided.

C. Combination of *Singer* and Official Notice

Claims 56-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Singer* in view of what was known in the art (Official Notice). This rejection is respectfully traversed.

Pursuant to *MPEP* § 2144.03, Applicant respectfully traverses the Examiner's taking of Official Notice. Applicant notes: "[T]he deficiencies of the cited references cannot be remedied by the Board's [or the Examiner's] general conclusions about what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art." *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). "[T]he the Board [or the Examiner] must point to some concrete evidence in the record in support of these findings." *Id.* at 1386 (emphasis added). Accordingly, Applicant submits claims 56-58 are nonobvious and allowable for at least the reason(s) provided.

D. Various claims not specifically addressed by the Examiner

The Examiner stated, "Claims 1-42, 64-169 contain substantially the same subject matter in claims 43-63 and are therefore rejected by the same rational. Other services including providing a map, a promotion, hotel etc. are disclosed by Muffat (fig. 3)". As discussed above, Applicant respectfully submits that there is no *prima facie* case of obvious to reject pending claims 1-69 and 78-177, using *Singer* and *Muffat*, taken both singly and in combination.

Furthermore, Applicant respectfully submits that *Singer* does not describe or render obvious "*wherein at least a portion of the content is capable of being displayed to a user of the computing device*" as recited in pertinent part by claim 170. Applicant submits that *Singer* nowhere describes or renders obvious that PLU 4 is capable of displaying any information it receives, and combining PLU 4 with a display device would "add undesirable bulk". Thus, combining PLU 4 and a display device would not permit PLU 4 to be miniaturized to be apparel such as an ornamental bracelet, an earring, "and the like", etc. Accordingly, Applicant respectfully submits that there is no *prima facie* case of obvious to reject claim 170, using *Singer* and *Muffat*, taken both singly and in combination. Therefore, Applicant submits that claim 170 is nonobvious and allowable for at least the reason(s) provided. Claims 172, 174, and 176 recite features similar to claim 170, and so the arguments presented above apply with equal force to

these claims, as well. Therefore, Applicant submits that claims 172, 174, and 176 are also nonobvious and allowable for at least the reason(s) provided.

Moreover, Applicant respectfully submits that *Singer* does not describe or render obvious "*wherein the computing device is a portable computing device configured to be readily carried by a user*" as recited in pertinent part by claim 171. Applicant submits that a combination of *Singer* and *Muffat* does not permit the computing device to be a portable computing device configured to be readily carried by a user. Applicant respectfully submits that an automobile is not configured to be readily carried by a user. Thus, Applicant respectfully submits that there is no *prima facie* case of obvious to reject claim 171 by combining *Singer* and *Muffat*. Therefore, Applicant submits that claim 171 is nonobvious and allowable for at least the reason(s) provided. Claims 173, 175, and 177 recite features similar to claim 171, and so the arguments presented above apply with equal force to these claims, as well. Therefore, Applicant submits that claims 173, 175, and 177 are also nonobvious and allowable for at least the reason(s) provided.

Further, claim 21 recites, *inter alia*:

acquiring preference information of a user over a period of time;
determining a geographic location of a computing device operated by the
user;
receiving identification information indicating the user from the
computing device; and
transmitting information to the computing device, wherein a content of the
information is dependent upon the geographic location of the computing device
and the preference information of the user of the computing device.

Singer and *Muffat*, taken both singly and in combination, nowhere describe or render obvious these features. Applicant respectfully points out that "[t]o reject a claim based on this rationale [Combining Prior Art Elements], Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following: □ (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;. . ." *MEPE* § 2143(A). Thus, Applicant respectfully submits that claim 21 is nonobvious and allowable for at least the

reason(s) provided. Claim 78 recites features similar to those recited by claim 21, and so the arguments presented above apply with equal force to claim 78, as well. Thus, Applicant respectfully submits that claim 78 is nonobvious and allowable for at least the reason(s) provided.

Claim 133 recites, *inter alia*:

wherein the information includes a promotion;

wherein the promotion is based upon the geographic location of the computing device.

Applicant respectfully submits that a combination with *Singer* would be improper to reject claim 133. Considering *Singer* in its entirety, i.e., as a whole, *Singer* leads away from Applicant's claim 133. Applicant respectfully submits that a kidnapped or lost child, toddler, or infant would have little to no use for receiving promotions based on his or her location within the technological environment provided by *Singer*. See *Singer* col. 1, lines 10-17 and col. 2, lines 26-34. Applicant respectfully submits that a person of ordinary skill in the art (at the time the invention recited in independent claim 133 was made) would conclude that a kidnapped or lost child, toddler, or infant would have little to no use for receiving promotions based on his or her location and based on the teaching(s) of *Singer*. Thus, Applicant respectfully submits that *Singer* leads away from the claimed invention as recited in claim 133. Applicant notes: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." *MPEP* § 2141.02(VI) (emphasis added). Thus, Applicant submits *Singer* teaches away from a combination with other prior art that describes a promotion as the Examiner suggests and cannot be used in a combination with at least *Muffat*. Therefore, Applicant respectfully submits that claim 133 is nonobvious and allowable for at least the reason(s) provided. Claims 142 and 154 recite features similar to those recited by claim 133, and so the arguments presented above apply with equal force to claims 142 and 154, as well. Thus, Applicant respectfully submits that claims 142 and 154 are nonobvious and allowable for at least the reason(s) provided.

Claim 36 recites, *inter alia*:

receiving a geographic location of an access point communicating with a first computing device;

receiving first identification information indicating a first user of the first computing device;

receiving the geographic location of the access point communicating with a second computing device, wherein the second computing device is different from the first computing device;

receiving second identification information indicating a second user of the second computing device, wherein the second identification is different from the first identification information, wherein the second user is different from the first user;

selecting first information dependent upon the geographic location of the access point and the first identification information, wherein at least a first content of the first information is capable of being displayed by the first computing device;

transmitting the first information to the first computing device;

selecting second information dependent upon the geographic location the access point and the second identification information, , wherein at least a second content of the second information is capable of being displayed by the second computing device, wherein the second information is different from the first information; and

transmitting the second information to the second computing device.

Applicant respectfully submits that *Singer* and *Muffat*, taken both singly and in combination, nowhere describe or render obvious these features. In one example, *Muffat* describes that "each cell broadcasts information to all equipped vehicles on a point-to-multipoint basis", and thus does not describe or render obvious individualizing information to computing devices communicating with the same access point. See *Muffat* page 932, paragraph 5. Thus, *Muffat* in its entirety, i.e., as a whole, *Muffat* leads away from Applicant's claim 36. In a second example, *Singer* nowhere describes or renders obvious that PLU 4 is capable of displaying any information it receives, and combining PLU 4 with a display device would "add undesirable bulk". Therefore, Applicant respectfully submits that *Singer* and *Muffat*, taken both singly and in combination, nowhere describe or render obvious claim 36. Therefore, Applicant submits that claim 36 is nonobvious and allowable for at least the reason(s) provided.

Applicant also respectfully submits that *Singer* and *Muffat*, taken both singly and in combination, nowhere describe or render obvious "receive a geographic location of a first access point of the one or more access points from a computing device communicatively coupled to the first access point; and transmit information to the computing device, wherein a content of the information is dependent upon the geographic location of the first access point received from the computing device" as recited in pertinent part by claim 11. Applicant submits that *Singer* nowhere provides any description that PLU 4 or mobile unit 6 provides a location of an access point and also submits that *Muffat* nowhere provides any description that any on-board system in an automobile provides a location of an access point. Applicant respectfully points out that "[t]o reject a claim based on this rationale [Combining Prior Art Elements], Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following: [] (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;. . ." *MPEP* § 2143(A). Thus, Applicant respectfully submits that *Singer* and *Muffat*, taken both singly and in combination, nowhere describe or render obvious claim 11. Therefore, Applicant submits that claim 11 is nonobvious and allowable for at least the reason(s) provided.

E. Various dependent claims

"If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." *MPEP* § 2143.03. Applicant respectfully submits that the pending independent claims have been shown to be nonobvious and allowable, and thus, Applicant submits that claims depending from the pending independent claims are also nonobvious and allowable for at least the reason(s) provided.

V. Conclusion

Having now responded to each rejection set forth in the present Office Action, Applicant believes all pending claims are now in condition for allowance and respectfully request such allowance. Applicant invites the Examiner to contact the undersigned at the below listed telephone number if a telephone conference would expedite prosecution of this application.

Respectfully submitted,



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